

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08-880-US10

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

09/684,388

Filed

October 4, 2000

First Named Inventor

David C. Gelvin

Art Unit

2431

Examiner

Aravind K. Moorthy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/David L. Ciesielski/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

David L. Ciesielski

Typed or printed name

☒ attorney or agent of record.
Registration number 57432

312 913 0001

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

November 12, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 08-880-US10)

In re the Application of:)	
)	
David C. Gelvin et al.)	
)	Examiner: Aravind K. Moorthy
Serial No.: 09/684,388)	
)	Art Unit: 2431
Filed: October 4, 2000)	
)	Confirmation No.: 9801
For: Method for Vehicle Internetworks)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR REVIEW OF THE FINAL REJECTION

Pursuant to the Pre-Appeal Brief Conference Program, Applicant requests review of the Final Office Action mailed on 18 June 2009 for the above-identified application because the Examiner has clearly erred in rejecting the pending claims of this application. In this paper, Applicant refers to the remarks of the Response after Final that was submitted to the Patent Office for this application on 18 August 2009 (hereinafter "*Response after Final*").

1. The claimed invention and status of the claims

Claims 1-66 and 76-82 are pending. Of the pending claims, claims 1, 66, and 77 are independent. Claim 1 and the claims depending from claim 1 are directed to methods for host vehicle internetworking. Claims 66, 77, and the claims depending from claim 77 are directed to methods for internetworking.

2. Summary of final office action

In the Final Office Action, the Examiner rejected claims 1-10, 15-18, 21, 25-32, 34-47, and 52-66 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,175,868 (Lavian),

(ii) the Examiner rejected claims 77 and 82 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,383,341 (Saito) and U.S. Patent No. 6,507,810 (Razavi), and (iii) the Examiner rejected each of claims 11-14, 19-20, 22-24, 33, 48-51, 69-74, 76, 78-82 under 35 U.S.C. § 103(a) as being obvious over 1 of 11 other combinations of references. A summary of these other obviousness rejections is located in the *Response after Final* at pg. 20, lines 5-23.

3. The Examiner's clear error in rejecting the claims

a. Claims 1-10, 15-18, 21, 25-32, 34-47, and 52-65

Independent claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Lavian. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Moreover, “[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983), 1548 (citing to *Soundsciber Corp. v. U.S.*, 360 F.2d 954, 960 (Ct. Cl. 1966) (emphasis added). Lavian does not teach or suggest each and every element as arranged in independent claim 1.

First, claim 1 recites, *inter alia*, “coupling a plurality of network elements in a vehicle, the vehicle including at least one node and at least one vehicle bus that is connected to at least one peripheral electronic device.” Lavian does not disclose or suggest a vehicle. Therefore, even if it is assumed, for the sake of argument, that Lavian discloses coupling a plurality of network elements, Lavian does not disclose or suggest coupling a plurality of network elements in a vehicle, the vehicle including at least one node and at least one vehicle bus that is connected to at least one peripheral electronic device, as this limitation is arranged in claim 1.

Next, claim 1 also recites “the plurality of network elements automatically assembling and configuring in response to the node information.” The Examiner cited to Lavian, column 4, line 62, to column 5, line 22 for disclosing this limitation of claim 1. This cited portion of Lavian discloses, *inter alia*, analyzing events and information 315 relating to network traffic to see if they meet one or more of a set of predefined threshold conditions, and if so, downloading network configuration software 313 to reconfigure a network switch 305. *See*, Lavian, column 5, lines 10-20. Reconfiguring a single element (i.e., network switch 305) does not amount to ***a plurality of network elements automatically assembling and configuring*** in response to node information. Applicant submits that the other portions of Lavian also do not disclose or suggest “the plurality of network elements automatically assembling and configuring in response to the node information.”

Moreover, as arranged in claim 1, the node information includes configuration and security information. Applicant submits that Lavian does not disclose or suggest that the events and information 315 includes configuration and security information, and thus Lavian’s events and information 315 does not amount to the node information recited in claim 1.

Since Lavian does not teach or suggest each and every element as arranged in claim 1, the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(e) as being anticipated by Lavian. Furthermore, since dependent claims 2-10, 15-18, 21, 25-32, 34-47, and 52-65 depend from claim 1 and necessarily include each and every limitation of claim 1, the Examiner erred in rejecting these dependent claims under 35 U.S.C. § 102(e) as being anticipated by Lavian.

b. Independent claim 66

The Examiner rejected independent claim 66 under 35 U.S.C. § 102(e) as being anticipated by Lavian. Since Lavian does not disclose or suggest a vehicle, Applicant submits

that Lavian does not disclose or suggest “coupling a plurality of network elements in a vehicle, the vehicle including at least one electronic device, at least one node and at least one vehicle bus,” as this limitation is arranged in claim 66. Applicant further refers the panel of examiners to the remarks in the *Response after Final* at pg. 23, line 5, to pg. 24, line 2.

Furthermore, Lavian does not disclose or suggest “at least one remote computer remotely accessing the plurality of network elements via at least one wireless Internet coupling,” as this limitation is arranged in claim 66. In the advisory action, the Examiner stated, “The applicant argues that Lavian does not disclose wireless Internet. Lavian discloses the communications take place through a mobile connection.” As far as Applicant can tell, the Examiner has equated a mobile connection as the claimed at least one wireless Internet coupling. With regard to a mobile connection, Lavian, at best, discloses that a network 1001 containing optivity software running on a NMS 1003 communicates via **Java mobile agents** 1004 with a file server, which may in turn communicates via transferred agents 1006 with a network switch 1007. Applicant submits that the Java mobile agents do not amount to a wireless Internet coupling, and the other portions of Lavian do not disclose or suggest a wireless Internet coupling. Applicant also refers the panel of examiners to the remarks in the *Response after Final* at pg. 24, lines 3-24.

Since Lavian does not disclose or suggest each and every element as arranged in claim 66, the Examiner erred in rejecting claim 66 under 35 U.S.C. § 102(e) as being anticipated by Lavian.

c. Independent claim 77

The Examiner erred in rejecting independent claim 77 under 35 U.S.C. § 103(a) as being obvious over Saito and Razavi because the Examiner has not articulated reasons with some rational underpinning to support the legal conclusion of obviousness of claim 77. For claim 77,

Applicant refers the panel of examiners to the remarks in the *Response after Final* at pg. 25, line 12, to pg. 27, line 5.

d. Dependent claims 11-14, 19, 20, 22-24, 33, 48-51, 69-74, 76, and 78-82

With regard to dependent claims 11-14, 19, 20, 22-24, 33, 48-51, 69-74, 76 and 78-82, Applicant refers the panel of examiners to the remarks in the *Response after Final*. For claims 69-74, see *Response after Final*, pg. 25, lines 5-11. For claim 82, see *Response after Final*, pg. 27, line 6, to pg. 28, line 7. For claims 11-14, 19 and 20, see *Response after Final*, pg. 28, lines 8-17. For claims 22-24, see *Response after Final*, pg. 28, line 18, to pg. 29, line 3. For claim 33, see *Response after Final*, pg. 29, lines 4-12. For claims 48-50, see *Response after Final*, pg. 29, lines 13-21. For claim 51, see *Response after Final*, pg. 30, lines 1-9. For claim 76, see *Response after Final*, pg. 30, line 10, to pg. 31, line 18. For claim 78, see *Response after Final*, pg. 31, line 19, to pg. 32, line 17. For claim 79, see *Response after Final*, pg. 32, line 18, to pg. 33, line 13. For claims 80 and 81, see *Response after Final*, pg. 33, line 14, to pg. 34, line 16.

4. Conclusion

For the foregoing reasons, Applicant submits that the Examiner clearly erred in rejecting claims 1-66 and 76-82. Pursuant to the Pre-Appeal Brief Conference Program, Applicant submits these Reasons for Review of the Final Rejection along with a Notice of Appeal and a Pre-Appeal Brief Request for Review, and Applicant respectfully requests review of the Final Office Action mailed 18 June 2009.

Respectfully submitted,

**McDonnell Boenhen
Hulbert & Berghoff LLP**

Date: 15 October 2009

By: /David L. Ciesielski/
David L. Ciesielski
Reg. No. 57,432